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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,530	01/24/2002	Leonard L. Diaddario, JR.	PVO 2 0009	4334

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EXAMINER

ZHENG, LOIS L

ART UNIT PAPER NUMBER

1742

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/056,530

Applicant(s)

DIADDARIO, ET AL.

Examiner

Lois Zheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 10 and 16-27 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-27 are currently pending in view of the amendment filed on 20 July 2004.

Claims 16-24 are allowable (see previous Office Action).

New claims 25-27 are added in view of the amendment.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 7 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higgins US 4,801,337(Higgins).

The examiner maintains the rejection of claims 1-2, 7 and 11-15 for the same reason disclosed in the previous Office Action as is incorporated herein.

The amendments in claims 1 and 14 merely clarify the language and grammar of the claims and do not change the substance of the claims.

**Response to Arguments**

4. Applicant's arguments, see page 6-7 section C of the amendment, filed 20 July 2004, with respect to claims 1-2, 7 and 11-15 have been fully considered but they are not persuasive.

In the remarks with respect to Higgins, applicants argued that:

- a) Higgins does not teach or show a mole ratio of nitrate to chromium plus cobalt ions of 1.5:1 or less;
- b) Higgins does not teach any specific nitrate ranges; and
- c) Higgins does not recognize the presence of either nitrate or the ratio of nitrate to Cr plus Co as important components.

In response to applicant's argument (a), the examiner relies on the more broad disclosure of polyvalent ion (e.g. cobalt) amount of 0.3 – 3 g/l. The amount of Co in Example 1, when implemented in an amount that is closer to the high limit of the disclosed range of Higgins(i.e. 3g/l), would significantly increase the total amount of Cr plus Co, which would produce a ratio of nitrate to Cr plus Co that is less than claimed ratio of 1.5:1. Therefore, the examiner maintains that the molar ratio of nitrate to Cr plus Co of Higgins overlaps the claimed ratio of nitrate to Cr plus Co of the instant invention.

5. In response to applicant's arguments (b) and (c), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, even though Higgins does not explicitly teach the significance of

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nitrate or the ratio of nitrate to Cr plus Co in the coating solution, it is sufficient for Higgins to teach the presence of nitrate as well as the ratio of nitrate to Cr plus Co in the coating solution as claimed. Mere recognition of another advantage of nitrate in the coating solution of Higgins does not render nonobvious an otherwise known invention. See MPEP 2145.

6. Applicant's arguments, see page 8 section D of the amendment, filed 20 July 2004, with respect to claims 3-6 and 8-10 have been fully considered and are persuasive. The rejection of 3-6 and 8-10 has been withdrawn.

***Allowable Subject Matter***

7. Claims 6, 10 and 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is an examiner's statement of reasons for allowance:

A primary reason for the allowance of claims 6, 10 and 25-27 is that the prior art fails to teach or suggest, either alone or in combination, the instantly claimed conversion coating bath composition where in the composition further comprises a film polisher agent with fluoride ion, sulfate ions and the coating bath is acidic.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LLZ

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